

REMARKS

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-4, 7-14 and 18-23 are pending. None of the claims have been amended. Accordingly, no new matter has been added.

In view of the remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

Issues Under 35 U.S.C. 103(a)

Claims 1-4, 8, 9, 11, 18, 19 and 22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over previously cited Shio. Claims 1, 7, 10, 12, 20, 21 and 23 stand rejected as obvious over Shio in view of previously cited Yoshimoto. Claims 1 and 13 stand rejected as unpatentable over Shio in view of previously cited Terasse. Claims 1, 2 and 14 stand rejected as obvious over Shio in view of previously cited Anderson. Applicants respectfully traverse each of these rejections.

The Examiner asserts that Shio discloses mesoporous silica and associated compositions that are useful as a carrier for cosmetics, pharmaceutical drugs and perfumes. The Examiner notes that Shio's compositions are obtained by a process comprising dissolving a silicate in the presence of a cationic surfactant (i.e. an organic raw material) wherein X-ray diffraction studies show a hexagonal structure for the silica pores. The Examiner takes the position that "Shio also establishes the particle size as a result effective variable since the particle size and amount of the powder correlates with the feel of the powder."

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness, the Examiner must make

the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int’l Co. v Teleflex Inc.*, 82 USPQ 2d 1385 (U.S. 2007). There must be a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. *Id.* The Supreme Court of the United States has recently held that the “teaching, suggestion, motivation test” is a valid test for obviousness, albeit one which cannot be too rigidly applied. *Id.* “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Initially, Applicants note that the present invention is patentable over the cited references at least for the reasons outlined in the Response to Non-Final Office Action filed on July 16, 2010. Moreover, Applicants submit that the presently claimed ranges (e.g., average pore size of from 0.8 to 3.3 nm, and average particle size of from 350 to 100µm) result in superior and unexpected results which rebut any *prima facie* case of obviousness allegedly established by the Examiner.

The Examiner’s attention is respectfully directed to the enclosed Declaration under 37 C.F.R. 1.132, which compares the porous silica of the present invention with the lumpy mesoporous silica of Shio. As discussed in the Declaration, each of the porous silicas was subjected to electron micrographic observations and a test for evaluating the sustained release properties thereof. As shown in Tables II and III in the Declaration, although the sensory

evaluations of fragrance are similar for both silicas (see, e.g., Table III), the porous silica of the present invention releases fragrance in a very small amount and thus exhibits a superior sustained release of the fragrance (see, e.g., Table II). Specifically, after three weeks, the present silica has a residual amount of lavender oil of 98.6%, whereas the porous silica of Shio only has a 59.2% residual amount. Applicants respectfully note that the superior results obtained by the present silica are unexpected and show that the present invention is not obvious over the cited prior art.

In view of the above, reconsideration and withdrawal of all rejections of record are respectfully requested.

Double Patenting Issues

Claims 1-4, 7-14 and 18-23 are provisionally rejected on the ground of nonstatutory obviousness double patenting as being unpatentable over claims 1, 2 and 4-8 of U.S. Patent Application No. 10/588,453 for the reasons set forth on pages 12-13 of the Office Action. Applicants respectfully traverse.

Applicants enclose herewith a Terminal Disclaimer, thus obviating this rejection. Reconsideration and withdrawal of this rejection are respectfully requested.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Registration No. 61,158 at the telephone number of the undersigned below to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Director is hereby authorized in this, concurrent, and future replies to charge any fees required during the pendency of the above-identified application or credit any overpayment to Deposit Account No. 02-2448.

Dated: January 13, 2011

Respectfully submitted,

By 

Craig A. McRobbie

Registration No.: 42874

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, VA 22040-0747

703-205-8000

Attachments: Executed Declaration Under 37 CFR 1.132
Terminal Disclaimer